APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,336	01/27/2000	Tomonori Minagawa		9757

			EXAMINER
5514	7590	07/13/2005	PHAM, THIERRY L

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ART UNIT	PAPER NUMBER
2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/492,336	MINAGAWA, TOMONORI
	Examiner	Art Unit	
	Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _25 April 2005_.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-32_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-32_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 4/25/05.

- Claims 1-32 are pending in application.

- Responsive to non-descriptive Title has been received and acknowledged (enter) by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 9-12, 17-20, 25-28 rejected under 35 U.S.C. 103(a) as being unpatentable

over Shima (US 6149323).

Regarding claim 1, Shima discloses an information processing apparatus (host computer 1, fig. 2) for producing print data (i.e. documents, fig. 2), which is interpretable by a printer (printers A & B, fig. 2), based on document data produced by an application (application incorporated within the host computer, fig. 2), comprising:

- combined settings registration means (host computer includes a setting device for receiving a setting value specifying a print mode "A1-B4", fig. 2, col. 2, lines 46-48) for combining each value of a plurality of setting items (i.e., paper orientation, page size, resolution, and color conversion, col. 5, lines 10-15) into a combined setting and for registering the combined setting by name in a combined setting list of a favorites database (the names of the stored setting values based upon user's interests can be displayed in the form of a list or a table, enabling the users to readily select a desired setting value, col. 3, lines 17-19 and Fig. 4, and col. 7, lines 40-49 and stored in database hard disk 55, fig. 4, the examiner interprets the stored setting files as shown in hard disk 55 as favorite database) is performed via a setting sheet (is performed via a user interface provided by printer driver 67, fig. 5);

- selection means (selector, col. 2, lines 49-52 and keyboard, fig. 4) for selecting one of the combined settings registered in said combine setting list by designation a name of one of the combined settings (, i.e., Fa1.EJL & Fa2.EJL, Fig. 4);

- display control means (host computer includes a monitor for displaying plurality of setting values files and for controlling display of each value of the plurality of the setting items all the setting items "Fa1.EJL", fig. 4, col. 3, lines 1-15 and col. 5, lines 35-40) of one combined setting in the setting sheet when the one combined setting is selected by said selection means;

- exporting and importing means (host computer 1, fig. 2) for exporting the combined setting as a setting file (exporting and storing the setting values as the setting files, i.e., A1-A4, fig. 2 and fig. 4, in the storage device of host computer) in response to an export instruction, and for importing the setting file (setting files can be imported to different host computers connected via a network and/or locally connected, col. 5, lines 1-20 and col. 6, lines 1-16) in response to an import instruction and adding the combined setting of the imported setting file into the favorites database (i.e. A1-A1, B1, fig. 6, the setting files that are being used frequently and displays as a list, col. 6, lines 48-60), but fails to teach a setting file, *which is able to be imported by a second printer driver* in response to an export instruction *on a user interface of a first printer driver* and to import setting file into the favorite database *of the first printer driver*.

Shima teaches a method for creating and storing (exporting) a setting value file (step S3, fig. 3 and col. 2, lines 45-67) to be used by different printer drivers (i.e. "each of the host computers 61A-61B can utilize the setting values determined by the other host computer, as well as the setting values determined by the host computer itself", col. 6, lines 1-16, and each host computer is equipped with different printer driver 67, fig. 5, col. 6, lines 16-20). In addition, each printer driver can displays a list of setting value files (i.e. A1-A4 and/or B1-B4, col. 3, lines 16-35 and col. 6, lines 48-637). In other words, print setting value files (A1-A4) generated by printer driver A (ref. 27A, fig. 2) and stored in table 41A (fig. 2) can be used with printer driver B (fig. 2), and vice versa. In addition, the print setting value files can be stored either in the host computer, printer, and/or any storage device (col. 3, lines 1-5); therefore, these files are transferable, for example, printer driver 27A generates setting value file (A1) and stores (i.e. equivalent to "export means" as cited by applicant) it on a storage device (i.e. storage device 66,

fig. 5). Obviously, setting value file (A1) can be imported to printer driver 27B and to generate a list of setting values files (col. 6, lines 55-60) for later use.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by combining the teaches of Shima because of a following reason: (●) allowing users using different printer driver to use the print setting value files generated by another users using different printer driver; by doing so, it improves the overall performance of the print system because it reduces the necessity (i.e. time consuming) of generating another print setting value files each time a print job is initiated.

Therefore, it would have been obvious to combine teachings of Shima to obtain the invention as specified in claim 1.

Regarding claim 2, Shima further discloses an information processing apparatus further comprising: input means (keyboard, col. 5, line 3) for inputting a name (the newly determined setting value is assigned a name and is stored in a hard disk, col. 5, lnies 3-5) of the combined settings, wherein said combined setting registration means registers the combined setting in association with the name inputted by said input means.

Regarding claim 3, Shima further discloses an information processing apparatus, wherein the combined setting can be registered by said combined setting registrations means from the plurality of setting sheets (resolution, paper orientation, page size settings sheets into a new setting value, col. 5, lines 10-20).

Regarding claim 4, Shima further discloses an information processing apparatus, wherein said printer is controlled by a printer driver ("printer driver", a device capable of activating or controlling a printer, col. 2, lines 25-29) which includes said combined setting registration means (Fig. 2, col. 4, lines 6-20).

Regarding claims 9-12: Claims 9-12 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-4; therefore, claims 9-12 are rejected for the same rejection rationale/basis as described in claims 1-4 above.

Regarding claims 17-20, 25-28: Claims 17-20, 25-28 recite limitations that are similar and in the same scope of invention as to those in claims 1-4 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. storage device 81, fig. 6) for storing computer programs, hence claims 17-20, 25-28 would be rejected using the same rationale as in claims 1-4.

Claims 5-7, 13-15, 21-23, 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima as described in claims 1, 9, 17, and/or 25 above, and in view of Maniwa et al (U.S. 5768483).

Regarding claim 5, Shima does not explicitly disclose wherein changing means for, in case of changing one value of the setting items via the setting sheet, changing the displayed name of the combined setting list so as to inform a user that the changed value is different from the value of the setting items associated with the name of the combined settings.

Maniwa, in the same field of endeavor for printer driver, discloses a changing means, for in case of changing one value of the setting items via the setting sheet, changing the displayed name of the combined setting list so as to inform a user that the changed value is different from the value of the setting items associated with the name of the combined settings (print profile/settings can be edited and changed to a different name, col. 9, lines 15-22 and col. 18, lines 20-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Shima as per teachings of Maniwa because of a following reason: (1) it is quick and cost effective by modifying an existed printer's profile (printer settings file) by changing one or more value of the existed file instead of creating a whole new file. (2) changing a modified file to a new/different name is to distinguish between an old file and new file

(obviously, the attributes of these two files are different; therefore, different names are needed for clarification).

Therefore, it would have been obvious to combine Shima with Maniwa to obtain the invention as specified in claim 5.

Regarding claim 6, Shima further discloses an information processing apparatus further comprising name assigning means for, when the setting items are changed (Fig. 3), displaying a name of the original combined setting and a change to the original combined setting in a recognizable manner (Fig. 3 shows S6, wherein if none of the setting values are selected from the setting values list, then the users proceed to generate a new setting value. The new setting value and old setting value are displayed on Fig. 4, i.e. "Fa2.EJL" and "Fa1.EJL", col. 7, lines 16-22).

Regarding claim 7, Shima further discloses an information processing apparatus, wherein a setting item of the combined setting has a registration function (a list of names of the document files corresponding to the conventional setting value values registered in the table is indicated on a display, col. 5, lines 28-39), and when detailed setting of the setting item is changed (if the user decides that the contents of the selected setting value "B1" are unacceptable, the user can enter a print instruction by inputting a new setting value from the input device, col. 7, lines 16-34) at a time when the changed detailed setting is not registered in the setting item, said name assigning means adds a temporary option (printer driver decides whether the user has selected an option for newly determining a setting value or not, col. 4, lines 65-67 and col. 5, lines 1-9 and Fig. 3) to a selection list and assigns the temporary option (paper orientation, col. 5, lines 1-20) to setting item set in the combined setting.

Regarding claims 13-15: Claims 13-15 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 5-7; therefore, claims 13-15 are rejected for the same rejection rationale/basis as described in claims 5-7 above.

Regarding claims 21-23, 29-31: Claims 21-23, 29-31 recite limitations that are similar and in the same scope of invention as to those in claims 5-7 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. storage device 81, fig. 6) for storing computer programs, hence claims 21-23, 29-31 would be rejected using the same rationale as in claims 5-7.

Claims 8, 16, 24, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima and Maniwa as applied to claim 7, 15, 23, and/or 31 above, and in view of Takahashi et al (U.S. 6424429).

Regarding claim 8, Shima does not disclose expressly an information processing apparatus, wherein the setting item having a registration function is a stamp setting for adding a stamp to the document data.

Takahashi discloses an information processing apparatus (computer, Fig. 1), wherein the setting item having a registration function is a stamp setting (setting data for a print mode includes "stamp setting" such as a message "Urgent" onto the document data, col. 15, lines 19-25) for adding a stamp to the document data.

Shima and Takahashi are combinable because they are from the same field of endeavor for information processing apparatus. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Shima's information processing apparatus by the teachings of Takahashi because of the following reasons: (1) to allow documents to be printed without having to reset the print mode settings when various documents are printed in a later time; thereby, reduces time and saves cost (Shima, col. 2, lines 15-20); (2) adding a stamp message "Urgent" to the document increases the importance of the document, allowing the users to respond to the document promptly and in a timely manner.

Therefore, it would have been obvious to combine Takahashi with Shima to obtain the invention as specified in claim 8.

Regarding claim 16: Claim 16 is the method claim corresponding to the apparatus claim 8. The methods are included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claim 8 above.

Claims 24 and 32 correspond to claim 8 except computer readable memory medium for storing program is claimed rather that printing system or data output apparatus. All computers have some type of computer readable memory medium (hard disk, fig. 4 of Shima) for storing computer programs, hence claims 24 and 32 would be rejected using the same rationale as in claim 8.

Response to Arguments

Applicant's arguments, see pages 14-15, filed 4/25/05, with respect to the rejection(s) of claim(s) 1 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretations of previous applied prior arts of record due to newly amended limitations.

• Regarding claims 1, 9, 17, and 25, the applicants argued the cited prior art of record (US 6149323 to Shima) fails to teach and/or suggest newly amended limitations "which is able to be imported by a second printer driver" and other features as cited in claims 1, 9, 17, and 25.

In response, the examiner notes new added features were not previous cited in claims 1, 9, 17, and 25. The examiner introduces a new ground of rejection in view of different interpretations of previous applied art; in other words, previous 102(e) rejection has been withdrawn and introduces a new 103(a) rejection. Please refer to rejection of claim 1 above for details.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after
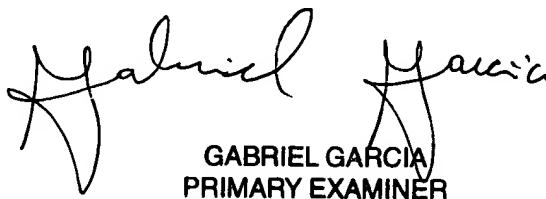
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

GABRIEL GARCIA
PRIMARY EXAMINER